UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,818	12/21/2000	Uwe Hansmann	DE919990102	8692

7590 07/07/2004	EXAMINER
Kevin P. Radigan, Esq.	HAMILTON, LALITA M

	ART UNIT	PAPER NUMBER

Kevin P. Radigan, Esq.
HESLIN & ROTHENBERG, P.C.
5 Columbia Circle
Albany, NY   12203

ART UNIT: 3624

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-24* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claims 10, 14, 20, and 22-24 are objected to because of the following informalities: In claims 10 and 14, the phrase "storing said a component" is unclear to the Examiner. In claim 20, there are two "the" after "performing". In claims 22-24, "if the product is implemented on a computer" is unclear. The Applicant should indicate that it is implemented on a computer. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Boers (5,637,846).

Boers discloses a method and a corresponding system and program product for electronic payment by a client in a self-service store comprising a contactless label chipcard attached to a product containing at least information for identifying said product and said payment status and a component for execution of the update of the payment status of said product (col.4, lines 1-14), a device for reading and initiating update of the payment status comprising at least: a contactless reader for reading information stored in said contacless label chipcard (col.4, lines 1-30), a component for generating invoice based on said information received from said contactless label chipcard (col.4, lines 1-30 and col.5, lines 15-25), a component for checking payment of said invoice (col.5, lines 15-65), and a component for initiating update of the payment status (col.5, lines 15-65); the label chipcard contains following information: Label ID, Product ID, Payment status PAID or NOT PAID, and AuthenticationKey (col.4, lines 1-30); label chipcard additionally contains product price information (col.4, lines 4-30); information are stored in the non-volatile memory of said label chipcard (col.4, lines 1-30); contactless reader comprising at least a component for sending to and receiving information from said label chipcard (col.4, lines 1-30); contactless reader uses inductive coupling for data transmission (col.4, lines 1-30); contactless label chipcard comprises at least a component for sending to and receiving information from said contactless reader (col.4, lines 1-30); contactless reader comprises at least a component for sending to and receiving information from said label chipcard, said contactless reader further comprising a generator for generating a RF-field whereby said contactless reader and said contactless label chipcard uses said RF-field for data transmission (col.4, lines 1-

30); component for generating an invoice has access to enterprise data not contained in said label chipcard for generating an invoice (col.5, lines 15-65); device for reading and initiating the update of the payment status further comprises a data processing device with non-volatile memory for storing said component for checking the payment of said invoice and said component for initiating the update of the payment status in said contactless label chipcard, a data connection between said data processing device and said reader, a display device for displaying invoice information, and a warning device for detecting not paid products (col.4, lines 1-30 and col.5, lines 5-65); a contact card reader as payment means and a contactless card reader as payment means (col.4, lines 1-30); device for reading and initiating the update of the payment status is part of a check-out system (col.5, lines 5-65); a component for sending to and receiving information from a contactless reader, a non-volatile memory containing at least following information: Label ID, Product ID, Payment status PAID or NOT PAID, and AuthenticationKey, and a component for execution of the update of the payment status by means of authentication (col.4, lines 1-30 and col.5, lines 1-65); a contactless reader for reading information stored in said contactless label chipcard, a component for generating an invoice based on said information received from said contactless label chipcard, a component for initiating update of the payment status on said label chipcard, a data processing device for storing said a component for checking the payment of said invoice and said component for initiating update of the payment status in said contactless label chipcard, a data connection between said data processing device and said reader, a display device for displaying invoice information, and a warning device for

detecting not paid products (col.4, lines 1-30 and col.5, lines 1-65); a method for

executing payments in a system comprising the steps of detecting presence of a

contactless label chipcard in the range of the contactless reader, requesting product

information from said detected label chipcard, storing product information in a memory

of said device, repeating aforementioned steps for all label chipcards detected in the

range of said contactless reader, generating invoice based on said information stored in

said memory, execution of payment and examination of validity of said payment,

sending "RequestSetPaid" with authentication protocol information by said component

for initiating update of the payment status via said contactless reader to a selected label

chipcard if the payment was valid, execution of said "RequestSetPaid" on said selected

label chipcard by said component for execution the update of the payment status when

the authentication protocol information provided with said "RequestSetPaid", repeating

execution step for all articles or products covered by the invoice, and inactivating said

warning system (col.4, lines 1-30 and col.5, lines 1-65); product information contains a

product identification ID and/or a product price information (col.4, lines 1-30); product

price information can be changed by an authorized device (col.4, lines 1-30); invoice is

generated with further product data identified by means of said information provided by

said label chipcard (col.5, lines 15-65); the execution of payment is supported by an

user interface with different option of payment (col.5, lines 15-65); the step of detecting

presence of the label chipcard comprises the further steps detecting presence of a

contactless payment chipcard in the range of the contactlesss reader and offering use

of the detected contactless payment chipcard for performing the payment (col.4, lines 1-

30 and col.5, lines 1-65); authentication protocol information is a digital signature or a

MAC execution of said "RequestSetPaid" on said selected label chipcard by said

component for execution; a computer program product stored in the internal memory of

a computer containing parts of software code for performance of the method of the

above claim if the product is implemented on the computer; (col.4, lines 1-30 and col.5,

lines 1-65); a computer program product stored in the internal memory of a computer

containing parts of software code for performance of the above claim if the product is

implemented on the computer (col.4, lines 1-30 and col.5, lines 1-65); and computer

program product stored in the internal memory of a computer containing parts of

software code for performance of the method of the above claim if the product is

implemented on the computer (col.4, lines 1-30 and col.5, lines 1-65).
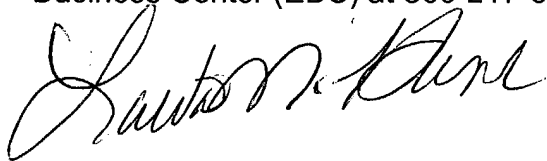
Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lalita M Hamilton whose telephone number is (703)

306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding

is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

LMH

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600